

they are to choose between one of the macro groupings and then for the elected group elect a single amino acid sequence.

Therefore, the Office has required restriction in the present application as follows:

Groups 1-6: Claims 1-10, drawn to a protein of amino acid sequence set forth in SEQ ID NO:3-8, respectively;

Group 7-12: Claims 3-10, drawn to an agonist to a protein of amino acid sequence set forth in SEQ ID NO:3-8;

Group 13-18: Claims 3-10, drawn to an agonist to a protein of amino acid sequences set forth in SEQ ID NO:3-8;

Group 19-23: Claims 11-12, drawn to a DNA encoding a protein of amino acid sequence set forth in SEQ ID NO:3-7; and

Group 24-29: Claims 13-14, drawn to a method of determining whether a test substance is an agonist or an antagonist of a protein of amino acid sequence set forth in SEQ ID NO: 3-8.

Applicants elect, with traverse, Group I (Groups 1-6), Claims 1-10, for further prosecution. In addition, Applicants elect, with traverse, SEQ ID NO:4 as a Species. Claims 1-8 and 10-14 read on the elected species.

With respect to Groups 1-29, the Office merely states its conclusion that these groups are independent and distinct. Applicants submit that the Office has not provided adequate reasons and/or examples to support this conclusion. The Office simply concludes that the protein of invention I can be used as a probe, or used therapeutically or diagnostically. Further, the Office has failed to show that the proposed use is materially different from the claimed use. In addition, no reasons and/or examples have been offered to support restriction between Groups 1-29. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Further, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

As stated above and based on the Examiner's statements in support of the Restriction Requirement, it is Applicants belief that the present action is a Restriction and Election of Species Requirement in which they are to choose between one of the macro groupings and then for the elected group elect a single amino acid sequence.

Accordingly, Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Vincent K. Shier, Ph.D.
Registration No.: 50,552



22850

PHONE NO.: (703) 413-3000
FAX NO.: (703) 413-2220
NFO:VKS
E:\209427US0-RE resp.wpd